

DETAILED ACTION

1. Claims 1 – 40 have been examined and are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 11, 23, 27, 29, 30, 33, 34 and 36 – 40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims all refer to computer-readable media or computer-executable instructions, which are clarified in paragraph [0052] to include carrier waves. Carrier waves and other similar transmission media are considered non-statutory subject matter.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1, 2, 4 – 9, 11 – 17, 23 – 27, 29 – 33, and 36 – 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pub. No. 2003/0212566 A1 to Fergusson et al. (hereinafter “Fergusson”) and further in view of U.S. Pub. No. 2004/0122730 A1 to Tucciarone et al. (hereinafter “Tucciarone”).

As to **Claim 1**, Fergusson teaches **a method for a sender of communications to comply with a predetermined time limit** (Paragraph [0011] – [0013] of Fergusson disclose determining if a valid prior existing relationship exists with a client by checking if a client has transacted business with the organization within the past year), **comprising:**

Fergusson does not explicitly teach but Tucciarone teaches **receiving an incoming communication from a recipient of communications** (Abstract of Tucciarone discloses that a person may request information in desired categories and then an advertiser may respond to the request. This is read to be the same as receiving a communication because the advertiser (sender) is receiving a request (incoming communication) from a person (recipient of communication));

Fergusson teaches **storing data indicating a last time that the incoming communication is received by the sender** (Paragraph [0012] of Fergusson discloses mining databases to determine the length of time since the client transacted business with

the organization. Since the system is mining a database for the information it inherently implies that at the time of transaction the time was stored in a database); **and**

sending a communication to the recipient if the stored data indicates that the time between the last time that the incoming communication is received by the sender and a present time does not exceed the predetermined time limit (Paragraphs [0011] – [0013] of Fergusson disclose that if a prior relationship exists the system will indicate to the telemarketer that the client may be contacted (read to be the same as sending a communication). It is then disclosed that a prior relationship is defined by determining the length of time since the client last transacted business with the organization (read to be the same as not exceeding a time limit)).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine receiving an incoming communication as taught by Tucciarone, with method to comply with a predetermined time limit as taught by Fergusson.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine in order to allow the Telemarketing system of Fergusson also accept incoming transactions. Although not explicitly stated it would be obvious to one of ordinary skill to have the system also accept incoming transactions along with their own outgoing transactions. Since the goal of any telemarketing firm would be to increase clientele it would be obvious to also add any clients who were willing to initiate contact since they would also be more likely to purchase the telemarketing firm's services.

"Common sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle...When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense." See *KSR v. Teleflex*, 550 U.S. ___, 127 S. Ct. 1727 (2007).

As to Claim 2, Fergusson and Tucciarone teach **the method of claim 1, wherein the incoming communication is received via one or more of the following: a direct communication, a postal mail, a data communication network, or a telephonic communication network** (Paragraphs [0011] – [0015] of Fergusson disclose telemarketing which implies telephonic communications, mailing to home addresses which is postal mail, and e-mailing which is seen as data communication).

As to Claim 4, Fergusson and Tucciarone teach **the method of claim 1, wherein said sending comprises sending the communication to the recipient if the stored data indicates that the present time is within a range prior to expiration of the predetermined time limit, said communication for inducing said recipient to send another incoming communication to the sender** (Paragraphs [0098] – [0102] of Fergusson disclose putting certain clients on high priority to be contacted so that they do

not become unreachable. This is done to establish a relationship before those clients are put on a Do-Not-Call (hereinafter DNC) list and become difficult to contact. Thus this is seen as contacting a client so that a relationship can be made (read to be the same as inducing the recipient to transact business) such that the company can contact them in the future).

As to Claim 5, Fergusson and Tucciarone teach **the method of claim 1, wherein if the time between the last time that the incoming communication is received and the present time exceeds the predetermined time limit, the communication is sent to the recipient via a channel permitted by a rule, law, or regulation that prescribes the predetermined time limit** (Paragraphs [0091] – [0094] of Fergusson disclose that some DNC laws only prevent an organization from contacting prospective clients on their home phone. Thus after obtaining their clients other information (home address or e-mail address) they can generate custom letters or marketing materials to be sent to the prospective clients via those channels instead. Doing so allows them to contact their clients without breaking DNC laws).

As to Claim 6, Fergusson and Tucciarone **teach the method of claim 1, further comprising:**

storing a list of recipients whose last time of incoming communications to the sender cannot be identified (Paragraph [0090] of Fergusson discloses a “On DNC List Without

Prior Or Existing Relationship” list This is read to be the list of people who do not have a prior relationship with the company and thus their last time of communication cannot be identified); **and**

wherein said sending the communication comprises sending the communication to the recipient if the recipient is included in said list of recipients, said communication for inducing the recipient to send another incoming communication to the sender

(Paragraphs [0098] – [0102] of Fergusson disclose putting certain clients on high priority to be contacted so that they do not become unreachable. This is done to establish a relationship before those clients are put on a Do-Not-Call (hereinafter DNC) list and become difficult to contact. Thus this is seen as contacting a client so that a relationship can be made (read to be the same as inducing the recipient to transact business) such that the company can contact them in the future).

As to Claim 7, Fergusson and Tucciarone teach **the method of claim 6, further comprising removing the recipient from said list of recipients after the recipient has sent another incoming communication to the sender** (Paragraph [0084] of Fergusson discloses a “On DNC List But With Prior Or Existing Relationship” list, a “On DNC List Without Prior Or Existing Relationship” list, and a “Free to Call” list. The existence of each of these lists implies that clients whose calling status changes will be moved to an appropriate list. As such in the situation where a client on the DNC list was contacted

and business was transacted it is likely the case that the client would then be moved to a more appropriate list reflecting the new relationship).

As to Claim 8, Fergusson and Tucciarone teach **the method of claim 1, further comprising:**

storing a list of recipients who are included in a do-not-send list (Paragraph [0090] of Fergusson discloses a “On DNC List Without Prior Or Existing Relationship” list where the names of prospective clients who fall under that category reside);

identifying if the recipient is included in said list of recipients (Paragraphs [0091] – [0094] of Fergusson disclose a representative contacting a client through channels other than the telephone in order comply with DNC laws. This action would inherently include identifying if their intended client is on the DNC list otherwise such an action to comply with the DNC laws would not be taken); **and**

wherein said sending the communication comprises sending the communication to the recipient via a permitted channel if the recipient is included in said list of recipients (Paragraphs [0091] – [0094] of Fergusson disclose that some DNC laws only prevent an organization from contacting prospective clients on their home phone. Thus after obtaining their clients other information (home address or e-mail address) they can generate custom letters or marketing materials to be sent to the prospective clients via

those channels instead. Doing so allows them to contact their clients without breaking DNC laws).

As to **Claim 9**, Fergusson and Tucciarone teach **the method of claim 8, wherein said sending further comprises sending the communication to the recipient via any channel if the recipient is included in said list of recipients and the time between the last time that the incoming communication is received and the present time does not exceed the predetermined time limit** (Paragraphs [0011] – [0012] of Fergusson disclose that if an existing relationship exists between the company and client (read to be the same as not exceeding the time limit as explained in paragraph [0012]) the telemarketer is free to contact the identified DNC client despite being on the DNC list).

As to **Claim 11**, Fergusson and Tucciarone teach **the method of claim 1, wherein one or more computer-readable media have computer-executable instructions for performing the method recited in claim 1** (Paragraph [0048] of Fergusson discloses a DNC handler block that performs processing to determine which DNC clients and be contacted and still maintain DNC compliance. This block implies the existence of computer instructions to make the block functional and thus reads upon the applicant's invention).

As to **Claim 12**, Fergusson and Tucciarone teach **a method for a sender of communications to comply with a rule, law, or regulation** (Abstract of Fergusson

discloses methods and systems provided for assisting organizations in complying with DNC laws), **comprising:**

Fergusson does not explicitly teach but Tucciarone teaches **receiving an incoming communication from a recipient of communications** (Abstract of Tucciarone discloses that a person may request information in desired categories and then an advertiser may respond to the request. This is read to be the same as receiving a communication because the advertiser (sender) is receiving a request (incoming communication) from a person (recipient of communication));

Fergusson teaches **identifying a location of the recipient based on the received incoming communication** (Paragraph [0015] of Fergusson discloses doing a reverse phone number lookup to find the home address of the DNC client);

storing data indicating the identified location of the recipient (Paragraph [0016] of Fergusson discloses a new account worksheet for keeping information such as the state of residence of the client. Then goes to say the information on the worksheet will be stored for at least the time period prescribed by appropriate DNC laws);

determining if a communication complies with a rule, law, or regulation of the identified location of the recipient (Paragraph [0088] of Fergusson discloses that some clients listed on an “On DNC List But With Prior Or Existing Relationship” list can be

contacted and others cannot. It then cites an example of one client being in Minnesota and able to be contacted and another client in Indiana who cannot be contacted despite both of them being on the list. This is explained to be because the definition of a relationship is different for each state. Given this example and the listing to support it, it is implied that Fergusson's invention would check to see if a call would comply with rules of the clients location); **and**

sending the communication to the recipient if the communication is determined to comply with the rule, law, or regulation of the identified location of the recipient (Paragraph [0088] of Fergusson discloses being able to contact a client who is in Minnesota because their prior relationship complies with DNC laws based on Minnesota's definition of prior relationship. Thus it is seen that after determining if the telemarketer's communication complies with DNC laws the telemarketer will contact the client).

Examiner recites the same rationale to combine used in claim 1.

As to Claim 13, Fergusson and Tucciarone teach **the method of claim 12, wherein said determining if the communication complies with the rule, law, or regulation of the identified location of the recipient comprises determining if the communication complies with the rule, law, or regulation via textual analysis of the communication** (Paragraphs [0091] – [0093] of Fergusson disclose an embodiment

where the communication can be done via e-mail or mail instead. In these situations because they are inherently text it would be obvious that any analysis done on them would be textual analysis. Thus it is seen that determination of compliance for this embodiment would inherently use textual analysis).

As to Claim 14, Fergusson and Tucciarone teach **the method of claim 12, wherein said determining if the communication complies with the rule, law, or regulation is performed in an electronic mail client** (Paragraph [0015] of Fergusson discloses that in one embodiment the system may generate an e-mail that can be sent to a client. Since the system that determines rule compliance also e-mails it can be viewed that an e-mail client is performing the rule compliance determination).

As to Claim 15, Fergusson and Tucciarone teach **the method of claim 12, wherein said sending the communication comprises sending the communication to the recipient via a channel permitted by the rule, law, or regulation of the identified location of the recipient if the communication is determined not to comply with the rule, law, or regulation** (Paragraphs [0091] – [0094] of Fergusson disclose that some DNC laws only prevent an organization from contacting prospective clients on their home phone. Thus after obtaining their clients other information (home address or e-mail address) they can generate custom letters or marketing materials to be sent to the prospective clients via those channels instead. Doing so allows them to contact their clients without breaking DNC laws).

As to Claim 16, Fergusson and Tucciarone teach **the method of claim 15**, **further comprising:**

receiving an input from the sender, said input indicating whether the communication complies with the rule, law, or regulation (Paragraph [0115] of Fergusson discloses a supervisor controls window that allows a compliance supervisor to set selected parameter values for states. For example the supervisor can set the level of what defines a states prior existing relationship. This is seen to be the same as the sender sending an input indicating compliance with rules); **and**

wherein said sending the communication comprises sending the communication to the recipient via any channel if the received input indicates that the communication complies with the rule, law, or regulation (Paragraphs [0011] – [0012] of Fergusson disclose that if an existing relationship exists between the company and client (read to be the same as not exceeding the time limit as explained in paragraph [0012]) the telemarketer is free to contact the identified DNC client despite being on the DNC list).

As to Claim 17, Fergusson and Tucciarone teach **the method of claim 12**, **wherein the location of the recipient is identified based on a postal address if the postal address is provided with the incoming communication, wherein the location**

of the recipient is identified based on an internet protocol address, server location, or domain name of the recipient if the incoming communication is received via a data communication network, and wherein the location of the recipient is identified based on a telephonic address of the recipient if the incoming communication is received via a telephonic communication network (Paragraph [0091] of Fergusson discloses that in some cases limited information known about a client can be provided to one or more databases to return additional contact information. In one scenario the home address of the client is gotten by a reverse phone number lookup database. Similarly the other methods (mail/e-mail) could be handled by a similar method to find the location of the client).

As to Claim 23, Fergusson and Tucciarone teach the method of claim 12, wherein one or more computer-readable media have computer-executable instructions for performing the method recited in claim 12 (Paragraph [0048] of Fergusson discloses a DNC handler block that performs processing to determine which DNC clients and be contacted and still maintain DNC compliance. This block implies the existence of computer instructions to make the block functional and thus reads upon the applicant's invention).

As to Claim 24, Fergusson and Tucciarone teach a system for a sender of communications to comply with a predetermined time limit (Paragraph [0011] – [0013] of Fergusson disclose determining if a valid prior existing relationship exists with

a client by checking if a client has transacted business with the organization within the past year), **comprising:**

a memory area adapted to store data indicating a last time that an incoming communication from a recipient is received by the sender (Paragraph [0012] of Fergusson discloses mining databases to determine the length of time since the client transacted business with the organization. Since the system is mining a database for the information it inherently implies that at the time of transaction the time was stored in a database. Also the database itself serves as the memory area mentioned in the claim);
and

a device adapted to send a communication to the recipient if the stored data indicates that the time between the last time that the incoming communication is received by the sender and a present time does not exceed the predetermined time limit (Paragraph [0015] of Fergusson discloses the system may help generate a mailing or e-mail that can be send to the prospective client. Then in paragraphs [0011] – [0013] it is disclosed that if a prior relationship exists the system will indicate to the telemarketer that the client may be contacted (read to be the same as sending a communication). It is then disclosed that a prior relationship is defined by determining the length of time since the client last transacted business with the organization (read to be the same as not exceeding a time limit)).

As to Claim 25, Fergusson and Tucciarone teach **the system of claim 24**, **wherein said device is a telephonic device, a server, or a client** (Paragraph [0015] of Fergusson discloses contacting clients at home via the phone which implies a telephonic device and also generating e-mails which implies a server/client type system).

As to Claim 26, Fergusson and Tucciarone teach **the system of claim 24**, **wherein the device is adapted to send the communication to the recipient if the stored data indicates that the present time is within a range prior to expiration of the predetermined time limit, said communication for inducing said recipient to send another incoming communication to the sender** (Paragraphs [0098] – [0102] of Fergusson disclose putting certain clients on high priority to be contacted so that they do not become unreachable. This is done to establish a relationship before those clients are put on a Do-Not-Call (hereinafter DNC) list and become difficult to contact. Thus this is seen as contacting a client so that a relationship can be made (read to be the same as inducing the recipient to transact business) such that the company can contact them in the future).

As to Claim 27, Fergusson and Tucciarone teach **the system of claim 24**, **wherein the memory area is adapted to store a list of recipients whose last time of incoming communications to the sender cannot be identified** (Paragraph [0090] of Fergusson discloses a “On DNC List Without Prior Or Existing Relationship.” This is read to be the list of people who do not have a prior relationship with the company and

thus their last time of communication cannot be identified. Where the existence of this list implies a memory area to store it in), **wherein the device is adapted to send the communication to the recipient if the recipient is included in said list of recipients, said communication for inducing the recipient to send another incoming communication to the sender** (Paragraphs [0098] – [0102] of Fergusson disclose putting certain clients on high priority to be contacted so that they do not become unreachable. This is done to establish a relationship before those clients are put on a Do-Not-Call (hereinafter DNC) list and become difficult to contact. Thus this is seen as contacting a client so that a relationship can be made (read to be the same as inducing the recipient to transact business) such that the company can contact them in the future), **and further comprising computer-executable instructions to remove the recipient from said list of recipients after the recipient has sent another incoming communication to the sender** (Paragraph [0084] of Fergusson discloses a “On DNC List But With Prior Or Existing Relationship” list, a “On DNC List Without Prior Or Existing Relationship” list, and a “Free to Call” list. The existence of each of these lists implies that clients whose calling status changes will be moved to an appropriate list. As such in the situation where a client on the DNC list was contacted and business was transacted it is likely the case that the client would then be moved to a more appropriate list reflecting the new relationship. In Figure 9 these lists are shown on a webpage, which implies a backend containing instructions to support the lists).

As to Claim 29, Fergusson and Tucciarone teach **a system for a sender of communications to comply with a rule, law, or regulation** (Abstract of Fergusson discloses methods and systems provided for assisting organizations in complying with DNC laws), **comprising:**

computer-executable instructions (Paragraph [0048] of Fergusson discloses a DNC handler block that performs processing to determine which DNC clients and be contacted and still maintain DNC compliance. This block implies the existence of computer instructions to make the block functional and thus reads upon the applicant's invention) **to identify a location of a recipient based on an incoming communication received from the recipient** (Paragraph [0015] of Fergusson discloses doing a reverse phone number lookup to find the home address of the DNC client and the abstract of Tucciarone discloses that a person may request information in desired categories and then an advertiser may respond to the request. This is read to be the same as receiving a communication because the advertiser (sender) is receiving a request (incoming communication) from a person (recipient of communication));

a memory area adapted to store data indicating the identified location of the recipient (Paragraph [0016] of Fergusson discloses a new account worksheet for keeping information such as the state of residence of the client. Then goes to say the information on the worksheet will be stored for at least the time period prescribed by appropriate

DNC laws. This implies the existence of a memory area to store the data else the data could not be stored);

computer-executable instructions to determine if a communication complies with a rule, law, or regulation of the identified location of the recipient (Paragraph [0048] of Fergusson discloses a DNC handler block that performs processing to determine which DNC clients and be contacted and still maintain DNC compliance (complying with DNC rules). This block implies the existence of computer instructions to make the block functional and thus reads upon the applicant's invention); **and**

a first device adapted to send the communication to the recipient if the communication is determined to comply with the rule, law, or regulation of the identified location of the recipient (Paragraph [0088] of Fergusson discloses being able to contact a client who is in Minnesota because their prior relationship complies with DNC laws based on Minnesota's definition of prior relationship. Thus it is seen that after determining if the telemarketer's communication complies with DNC laws the telemarketer will contact the client).

Examiner recites the same rationale to combine used in claim 1.

As to Claim 30, Fergusson and Tucciarone teach the system of claim 29, wherein said computer-executable instructions to determine if the communication

complies with the rule, law, or regulation comprises electronic mail client instructions (Paragraph [0015] of Fergusson discloses that in one embodiment the system may generate an e-mail that can be sent to a client. Since the system that determines rule compliance also e-mails it can be viewed that an e-mail client is performing the rule compliance determination. Further since the system that does the determination of compliance was shown above to use computer instructions it is implied that the electronic mail client would also be supported similarly).

As to **Claim 31**, Fergusson and Tucciarone teach **the system of claim 29, wherein the location of the recipient is identified based on a postal address if the postal address is provided with the incoming communication, wherein the location of the recipient is identified based on an internet protocol address, server location, or domain name of the recipient if the incoming communication is received via a data communication network, and wherein the location of the recipient is identified based on a telephonic address of the recipient if the incoming communication is received via a telephonic communication network** (Paragraph [0091] of Fergusson discloses that in some cases limited information known about a client can be provided to one or more databases to return additional contact information. In one scenario the home address of the client is gotten by a reverse phone number lookup database. Similarly the other methods (mail/e-mail) could be handled by a similar method to find the location of the client).

As to Claim 32, Fergusson and Tucciarone teach **the system of claim 29**, **wherein the first device is adapted to send the communication to the recipient via a channel permitted by the rule, law, or regulation of the identified location of the recipient if the communication is determined not to comply with the rule, law, or regulation** (Paragraphs [0091] – [0094] of Fergusson disclose that some DNC laws only prevent an organization from contacting prospective clients on their home phone. Thus after obtaining their clients other information (home address or e-mail address) they can generate custom letters or marketing materials to be sent to the prospective clients via those channels instead. Doing so allows them to contact their clients without breaking DNC laws).

As to Claim 33, Fergusson and Tucciarone teach the system of claim 32, further comprising:

computer-executable instructions to receive an input from the sender, said input indicating whether the communication complies with the rule, law, or regulation (Paragraph [0115] of Fergusson discloses a supervisor controls window that allows a compliance supervisor to set selected parameter values for states. For example the supervisor can set the level of what defines a states prior existing relationship. This is seen to be the same as the sender sending an input indicating compliance with rules. The control window mentioned is shown in Figure 13 to be a website, which implies a backend containing instructions to support control window); **and**

wherein the first device is adapted to send the communication to the recipient via any channel if the received input indicates that the communication complies with the rule, law, or regulation (Paragraphs [0011] – [0012] of Fergusson disclose that if an existing relationship exists between the company and client (read to be the same as not exceeding the time limit as explained in paragraph [0012]) the telemarketer is free to contact the identified DNC client despite being on the DNC list).

As to Claim 36, Fergusson and Tucciarone teach one or more computer-readable media having computer-executable components for a sender of

communications to comply with a predetermined time limit (Paragraph [0048] of Fergusson discloses a DNC handler block that performs processing to determine which DNC clients and be contacted and still maintain DNC compliance. This block implies the existence of computer instructions to make the block functional and thus reads upon the applicant's invention), **said computer-readable media comprising:**

Fergusson does not explicitly teach but Tucciarone teaches **a receiving component for receiving an incoming communication from a recipient of communications** (Abstract of Tucciarone discloses that a person may request information in desired categories and then an advertiser may respond to the request. This is read to be the same as receiving a communication because the advertiser (sender) is receiving a request (incoming communication) from a person (recipient of communication));

Fergusson teaches **a storage component for storing data indicating a last time that the incoming communication is received by the sender** (Paragraph [0012] of Fergusson discloses mining databases to determine the length of time since the client transacted business with the organization. Since the system is mining a database for the information it inherently implies that at the time of transaction the time was stored in a database); **and**

sending component for sending a communication to the recipient if the stored data indicates that the time between the last time that the incoming communication is

received by the sender and a present time does not exceed the predetermined time limit (Paragraphs [0011] – [0013] of Fergusson disclose that if a prior relationship exists the system will indicate to the telemarketer that the client may be contacted (read to be the same as sending a communication). It is then disclosed that a prior relationship is defined by determining the length of time since the client last transacted business with the organization (read to be the same as not exceeding a time limit)).

As to Claim 37, Fergusson and Tucciarone teach **the computer-readable media of claim 36, wherein the sending component sends the communication to the recipient if the stored data indicates that the present time is within a range prior to expiration of the predetermined time limit, said communication for inducing said recipient to send another incoming communication to the sender** (Paragraphs [0098] – [0102] of Fergusson disclose putting certain clients on high priority to be contacted so that they do not become unreachable. This is done to establish a relationship before those clients are put on a Do-Not-Call (hereinafter DNC) list and become difficult to contact. Thus this is seen as contacting a client so that a relationship can be made (read to be the same as inducing the recipient to transact business) such that the company can contact them in the future).

As to Claim 38, Fergusson and Tucciarone **the computer-readable media of claim 36, wherein the storage component stores a list of recipients whose last time of incoming communications to the sender cannot be identified** (Paragraph [0090] of

Fergusson discloses a “On DNC List Without Prior Or Existing Relationship” list This is read to be the list of people who do not have a prior relationship with the company and thus their last time of communication cannot be identified), **and wherein the sending component sends the communication to the recipient if the recipient is included in said list of recipients, said communication for inducing the recipient to send another incoming communication to the sender** (Paragraphs [0098] – [0102] of Fergusson disclose putting certain clients on high priority to be contacted so that they do not become unreachable. This is done to establish a relationship before those clients are put on a Do-Not-Call (hereinafter DNC) list and become difficult to contact. Thus this is seen as contacting a client so that a relationship can be made (read to be the same as inducing the recipient to transact business) such that the company can contact them in the future).

As to Claim 39, Fergusson and Tucciarone teach **the computer-readable media of claim 36, wherein the storage component stores a list of recipients who are included in a do-not-send list** (Paragraph [0090] of Fergusson discloses a “On DNC List Without Prior Or Existing Relationship” list where the names of prospective clients who fall under that category reside), **and wherein the sending component sends the communication to the recipient via a permitted channel if the recipient is included in said list of recipients** (Paragraphs [0091] – [0094] of Fergusson disclose that some DNC laws only prevent an organization from contacting prospective clients on their home phone. Thus after obtaining their clients other information (home address or e-mail address) they can generate custom letters or marketing materials to be sent to the

prospective clients via those channels instead. Doing so allows them to contact their clients without breaking DNC laws).

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fergusson and Tucciarone as applied to claim 1 above, and further in view of Tucciarone.

As to Claim 10, Fergusson and Tucciarone teach **the method of claim 1.**

Fergusson and Tucciarone as applied to claim 1 do not teach but Tucciarone teaches **wherein the sender is a group** (Paragraph [0022] of Tucciarone discloses the system matches the requests of users (clients) with information inventory of multiple suppliers (read to be a group of senders)), **wherein said incoming communication from the recipient is received by one of the group** (Abstract of Tucciarone discloses that a person may request information in desired categories and then an advertiser may respond to the request. This is read to be the same as receiving a communication because the advertiser (sender) is receiving a request (incoming communication) from a person (recipient of communication)). Ferguson teaches **wherein said storing comprises storing data indicating the last time that the incoming communication is received by said one of the group** (Paragraph [0012] of Fergusson discloses mining databases to determine the length of time since the client transacted business with the organization. Since the system is mining a database for the information it inherently implies that at the time of transaction the time was stored in a database), **and wherein said sending comprises sending the communication from said one of the group to the recipient if**

the time between the last time that the incoming communication is received by said one of the group and the present time does not exceed the predetermined time limit (Paragraphs [0011] – [0013] of Fergusson disclose that if a prior relationship exists the system will indicate to the telemarketer that the client may be contacted (read to be the same as sending a communication). It is then disclosed that a prior relationship is defined by determining the length of time since the client last transacted business with the organization (read to be the same as not exceeding a time limit)).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of claim 1 as taught by Fergusson and Tucciarone, with making the sender a group as taught by Tucciarone.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine in order to (paragraphs [0014] – [0020] of Tucciarone) give clients easier access to more information and so allow for a simple and easy way to receive services from multiple suppliers.

8. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fergusson and Tucciarone as applied to claim 24 above, and further in view of Tucciarone.

As to Claim 28, Fergusson and Tucciarone teach **the system of claim 24.**

Fergusson and Tucciarone as applied to claim 24 do not teach but Tucciarone teaches **wherein the sender is a group** (Paragraph [0022] of Tucciarone discloses the system

matches the requests of users (clients) with information inventory of multiple suppliers (read to be a group of senders)), **wherein the memory area is adapted to store data indicating the last time that the incoming communication from the recipient is received by one of the group** (Paragraph [0012] of Fergusson discloses mining databases to determine the length of time since the client transacted business with the organization. Since the system is mining a database for the information it inherently implies that at the time of transaction the time was stored in a database. Also the database itself serves as the memory area mentioned in the claim), **and wherein the device is adapted to send the communication from said one of the group to the recipient if the time between the last time that the incoming communication is received by said one of the group and the present time does not exceed the predetermined time limit** (Paragraph [0015] of Fergusson discloses the system may help generate a mailing or e-mail that can be send to the prospective client. Then in paragraphs [0011] – [0013] it is disclosed that if a prior relationship exists the system will indicate to the telemarketer that the client may be contacted (read to be the same as sending a communication). It is then disclosed that a prior relationship is defined by determining the length of time since the client last transacted business with the organization (read to be the same as not exceeding a time limit)).

Examiner recites the same rationale to combine used in claim 10.

9. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fergusson and Tucciarone as applied to claim 36 above, and further in view of Tucciarone.

As to Claim 40, Fergusson and Tucciarone teach **the computer-readable media of claim 36**. Fergusson and Tucciarone as applied to claim 36 do not teach but Tucciarone teaches **wherein the sender is a group** (Paragraph [0022] of Tucciarone discloses the system matches the requests of users (clients) with information inventory of multiple suppliers (read to be a group of senders)), **wherein said incoming communication from the recipient is received by one of the group** (Abstract of Tucciarone discloses that a person may request information in desired categories and then an advertiser may respond to the request. This is read to be the same as receiving a communication because the advertiser (sender) is receiving a request (incoming communication) from a person (recipient of communication)). Ferguson teaches **wherein the storage component stores data indicating the last time that the incoming communication is received by said one of the group** (Paragraph [0012] of Fergusson discloses mining databases to determine the length of time since the client transacted business with the organization. Since the system is mining a database for the information it inherently implies that at the time of transaction the time was stored in a database), **and wherein the sending component sends the communication from said one of the group to the recipient if the time between the last time that the incoming communication is received by said one of the group and the present time does not**

exceed the predetermined time limit (Paragraphs [0011] – [0013] of Fergusson disclose that if a prior relationship exists the system will indicate to the telemarketer that the client may be contacted (read to be the same as sending a communication). It is then disclosed that a prior relationship is defined by determining the length of time since the client last transacted business with the organization (read to be the same as not exceeding a time limit)).

Examiner recites the same rationale to combine used in claim 10.

10. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fergusson and Tucciarone as applied to claim 12 above, and further in view of U.S. Pub. No. 2004/0017899 A1 to Garfinkel et al. (hereinafter “Garfinkel”).

As to Claim 20, Fergusson and Tucciarone teach the method of claim 12, wherein said sending the communication to the recipient comprises:

Fergusson and Tucciarone do not teach but Garfinkel teaches **effecting compliance of the communication with the rule, law, or regulation of the identified location of the recipient if the communication is determined not to comply with the rule, law, or regulation** (Abstract of Garfinkel discloses determining if a call requires caller ID information and then if it is determined that caller ID information is required the system will provide a predetermined called ID information packet with the call. Otherwise if the

call is determined to not require caller ID information the system will allow the call to continue freely); **and**

sending the compliant communication to the recipient (Paragraph [0011] of Garfinkel discloses then routing the call to its final destination).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of claim 12 as taught by Fergusson and Tucciarone, with effecting compliance on a communication as taught by Garfinkel.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine in order to (paragraph [0003] of Garfinkel) assure compliance with Federal and State Caller ID transmission rules. In the case of e-mail it would be similarly beneficial to add compliance to adhere to DNC rules.

As to Claim 21, Fergusson, Tucciarone, and Garfinkel teach the method of claim 20, wherein said effecting compliance of the communication comprises including one or more of the following information in the communication if required by the rule, law, or regulation of the identified location of the recipient: a labeling that the communication is unsolicited, an address of the sender, a phone number of the sender, or unsubscription information (Abstract of Garfinkel discloses determining if a call requires caller ID information and then if it is determined that caller ID information is required the system will provide a predetermined called ID information

packet with the call. Otherwise if the call is determined to not require caller ID information the system will allow the call to continue freely).

Examiner recites the same rationale to combine used in claim 20.

11. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fergusson and Tucciarone as applied to claim 29 above, and further in view Garfinkel.

As to Claim 34, Fergusson and Tucciarone teach **the system of claim 29, further comprising computer-executable instructions to effect compliance of the communication with the rule, law, or regulation of the identified location of the recipient if the communication is determined not to comply with the rule, law, or regulation** (Abstract of Garfinkel discloses determining if a call requires caller ID information and then if it is determined that caller ID information is required the system will provide a predetermined called ID information packet with the call. Otherwise if the call is determined to not require caller ID information the system will allow the call to continue freely), **and wherein the first device is adapted to send the compliant communication to the recipient** (Paragraph [0011] of Garfinkel discloses then routing the call to its final destination).

Examiner recites the same rationale to combine used in claim 20.

12. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fergusson and Tucciarone as applied to claim 12 above, and further in view of U.S. Pub. No. 2004/0128321 A1 to Hamer (hereinafter “Hamer”).

As to Claim 18, Fergusson and Tucciarone teach **the method of claim 12**, Fergusson and Tucciarone do not teach but Hamer teaches **wherein if multiple locations of the recipient are identified, the location of the recipient is the location having the most restrictive rule law, or regulation among the identified multiple locations** (Paragraphs [0056] – [0059] of Hamer disclose a rule engine that selects which rules to follow based on specific criteria. It further explains that in the case where more than one rule set is applicable the engine locates the primary rule set by finding the highest-ranking rule set with the most restrictive action value. In Fergusson it was disclosed that a supervisor could set the various rules associated with the different states (seen to be the same as having more than one applicable rule set). Thus when the rule engine is combined with the rule sets of the various states it can be seen that the same idea is taught).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of claim 12 as taught by Fergusson and Tucciarone, with the rule engine as taught by Hamer.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine in order to comply with DNC laws. As taught by Fergusson the entire invention pertains to preventing a company from unintentionally breaking laws

dealing with DNC lists. As such it would be obvious in the scenario where a client is potentially affected by two laws to choose the more restrictive one. For if the company complies with the more restrictive rule set there is no way the company can accidentally break the law in either state. If, however, the company chose the more lenient rule set there would be the potential for breaking the law in the other state. Thus it would be obvious to implement the rule engine feature in the scenario where a client is based in more than one state.

"Common sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle...When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense." See *KSR v. Teleflex*, 550 U.S. ___, 127 S. Ct. 1727 (2007).

As to Claim 19, Fergusson and Tucciarone teach **the method of claim 12**, Fergusson and Tucciarone do not teach but Hamer teaches **wherein the location of the recipient is a location having the most restrictive rule, law, or regulation if the location of the recipient cannot be identified** (Paragraphs [0056] – [0059] of Hamer disclose a rule engine that selects which rules to follow based on specific criteria. It further explains that in the case where more than one rule set is applicable the engine

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locates the primary rule set by finding the highest-ranking rule set with the most restrictive action value. In Fergusson it was disclosed that a supervisor could set the various rules associated with the different states (seen to be the same as having more than one applicable rule set). Thus when the rule engine is combined with the rule sets of the various states it can be seen that the same idea is taught).

Examiner recites the same rationale to combine used in claim 19.

13. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fergusson and Tucciarone as applied to claim 1 above, and further in view of U.S. Pat. No. 5850520 to Griebenow et al. (hereinafter "Griebenow").

As to Claim 3, Fergusson and Tucciarone teach **the method of claim 1.**

Fergusson and Tucciarone do not explicitly teach but Griebenow teaches **further comprising sending information to the recipient, said information indicating the last time that the incoming communication from the recipient is received** (Column 8 lines 30 – 50 of Griebenow disclose determining whether it is time to send a renewal notice to the consumer because the consumer's subscriptions to the publication has lapsed or is about to lapse. Renewal notices will explicitly or implicitly (through the date of expiration) disclose the last time the consumer communicated with the service).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of claim 1 as taught by Fergusson and Tucciarone, with informing the consumer of their last time of communication as taught by Griebenow.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine in order to encourage the extension of their current relationships.

Sending subscription renewal notices is commonly known as a method used by magazines or other services to inform clients of their dates of expiration as well as to encourage them to renew their relationship. Since the scenario is very similar to the relationship involved in mailing clients advertisements it would be obvious to use a similar method to also retain their client base.

"Common sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle...When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense." See *KSR v. Teleflex*, 550 U.S. ___, 127 S. Ct. 1727 (2007).

14. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fergusson and Tucciarone as applied to claim 12 above, and further in view of U.S. Pat. No. 7155608 B1 to Malik et al. (hereinafter "Malik").

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As to Claim 22, Fergusson and Tucciarone teach the method of claim 12.

Fergusson and Tucciarone do not teach but Malik teaches **further comprising using a first computer having a first internet protocol address or domain to send the communication to the recipient if the communication is determined to comply with the rule, law, or regulation of the identified location of the recipient and using a second computer having a second internet protocol address or domain different from the first internet protocol address or domain to send the communication to the recipient if the communication is determined not to comply with the rule, law, or regulation of the identified location of the recipient** (Column 1 lines 30 – 67 and Column 2 lines 1 – 30 of Malik disclose that a current method employed by spammers is to use a different IP address in case their current one gets blocked. This is seen to be implementing the same idea as the applicant's invention. The first computer exists to take care of compliant e-mail and the second computer exists to send out e-mail that is not compliant. Similarly Malik describes a system where a spammer will mail out from one IP until that IP is blocked and then begin to mail from another IP. The essential thing being that when the circumstances change they both change IP's to circumvent the current problem).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of claim 12 as taught by Fergusson and Tucciarone, with changing IP addresses to bypass the situation as taught by Malik.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine in order to further extend the idea of circumventing the DNC laws. Fergusson teaches using other methods such as e-mail or snail mail to circumvent not being able to call the DNC numbers. Had a rule existed such that the telemarketer could simply use a different phone line and still be within DNC compliance it would have been obvious to add such a feature to the invention disclosed in Fergusson.

"Common sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle...When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense." See *KSR v. Teleflex*, 550 U.S. ___, 127 S. Ct. 1727 (2007).

15. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fergusson and Tucciarone as applied to claim 12 above, and further in view of Malik.

As to Claim 35, Fergusson and Tucciarone teach **the system of claim 29**.

Fergusson and Tucciarone do not teach but Malik teaches **further comprising: a second device having a second internet protocol address or domain and adapted to send the communication to the recipient if the communication is determined not to comply**

with the rule, law, or regulation of the identified location of the recipient; and wherein the first device has a first internet protocol address or domain different from the second internet protocol address or domain and is adapted to send the communication to the recipient if the communication is determined to comply with the rule, law, or regulation of the identified location of the recipient (Column 1 lines 30 – 67 and Column 2 lines 1 – 30 of Malik disclose that a current method employed by spammers is to use a different IP address in case their current one gets blocked. This is seen to be implementing the same idea as the applicant's invention. The first computer exists to take care of compliant e-mail and the second computer exists to send out e-mail that is not compliant. Similarly Malik describes a system where a spammer will mail out from one IP until that IP is blocked and then begin to mail from another IP. The essential thing being that when the circumstances change they both change IP's to circumvent the current problem).

Examiner recites the same rationale to combine used in claim 22.

Conclusion

Prior art(s) made of record but not relied upon:

U.S. Pat. No. 6330317 to Garfinkel – Call Blocking System

U.S. Pat. No. 6130937 to Fotta – System and Process for Automatic Storage,
Enforcement and Override of Consumer Do-Not-Call Requests

U.S. Pat. No. 6965920 to Pedersen – Profile Responsive Electronic Message
Management System

U.S. Pat. No. 6691156 to Drummond et al. – Method for Restricting Delivery of
Unsolicited E-mail

U.S. Pat. No. 6944628 to De Breed – Method for Electronically Addressing of a Person
or Organization

U.S. Pat. No. 7293065 to Banister et al. – Method of Electronic Message Delivery with
Penalties for Unsolicited Messages

U.S. Pat. No. 6587550 to Council et al. – Method and Apparatus for Enabling a Fee to be
Charged to a Party Initiating an Electronic Mail Communication when the Party is not on an
Authorization List Associated with the Party to Whom the Communication is Directed

U.S. Pub. No. 2002/0120600 to Schiavone et al. – System and Method for Rule-Based
Processing of Electronic Mail Messages

U.S. Pub. No. 2005/0074114 to Fotta et al. – Do-Not-Call Compliance Management for
Predictive Dialer Call Centers

U.S. Pub. No. 2002/0059381 to Cook et al. – Method and System for Linking an Electronic Address to a Physical Address of a Customer

U.S. Pub. No. 2003/0074411 to Nale – Method and System for Postal Service Mail Delivery via Electronic Mail

U.S. Pub. No. 2004/0010552 to Keohane et al. – Electronic Mail Distribution via a Network of Computer Controlled Display Terminals with Interactive Display Interfaces Enabling Senders to Specify Individuals not to Receive the E-mail Documents Being Sent

U.S. Pub. No. 2005/0076220 to Zhang et al. – Method and Ssystem for Using a Point System to Deliver Advertisement E-mails and to Stop Spam

U.S. Pub. No. 2004/0199595 to Banister et al. – Electronic Message Delivery Using a Virtual gateway Approach

U.S. Pub. No. 2003/0229668 to Malik – Systems and Methods for Delivering Time Sensitive Messages over a Distributed Network

U.S. Pub. No. 2005/0021649 to Goodman et al. – Prevention of Outgoing Spam

U.S. Pub. No. 2005/0165892 to Kelly – Process to Prevent the Sending of Unwanted E-mail(Spam)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin S. Mai whose telephone number is 571-270-5001. The examiner can normally be reached on Monday through Friday 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Taghi Arani can be reached on 571-272-3787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KSM

/Taghi T. Arani/

Supervisory Patent Examiner, Art Unit 4121

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